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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/681,448	04/07/2001	Eric Schneider		4744
24226	7590	03/30/2004		
			EXAMINER	
			BORISOV, IGOR N	
			ART UNIT	PAPER NUMBER
			3629	

DATE MAILED: 03/30/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No.	Applicant(s)
	09/681,448	SCHNEIDER, ERIC
Examiner	Art Unit	
Igor Borissov	3629	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 03 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) Responsive to communication(s) filed on 07 April 2001.
- 2a) This action is **FINAL**. 2b) This action is non-final.
- 3) Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) Claim(s) 1-25 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) Claim(s) _____ is/are allowed.
- 6) Claim(s) 1-25 is/are rejected.
- 7) Claim(s) _____ is/are objected to.
- 8) Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) The specification is objected to by the Examiner.
- 10) The drawing(s) filed on _____ is/are: a) accepted or b) objected to by the Examiner.
 Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
 Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
 - a) All b) Some * c) None of:
 1. Certified copies of the priority documents have been received.
 2. Certified copies of the priority documents have been received in Application No. _____.
 3. Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|---|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____. |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____. | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| | 6) <input type="checkbox"/> Other: _____. |

DETAILED ACTION

Claim Rejections - 35 USC § 112

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

Claim 6 is rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Claim 6, which depends on **claim 5**, is confusing, because **claim 6** implies plural, simultaneous types of said received communication from the subscriber, while the **claim 5** teaches only one type.

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 1-25 are rejected under 35 U.S.C. 103(a) as being unpatentable over Quatse et al. (US 5,991,368) in view of Trell (US 6,393,117).

Quatse et al. (Hereinafter Quatse) teaches customer information announcement method and system, comprising:

Independent Claims.

Claims 1 and 21-24. Maintaining database (list) of customers (column 1, lines 51-52); receiving dialed digits from a calling party corresponding to a phone number (column 3, lines 10-12); attempting to place a phone call connection from

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said calling party through the network to said phone number (column 3, lines 13-16); determining that said phone number is one of a changed phone number (column 3, lines 32-33); communicating with said calling party to offer additional information related to the telephone number entered (column 5, lines 10-12).

Quatse does not specifically teach that said additional information includes inquiry for determination whether said calling party may be interested in subscribing to any available additional phone number.

Trell teaches a telephonic method and system, wherein a subscriber is offered an additional telephone number from a list of available, unused telephone numbers (column 1, lines 49-50; column 5, lines 45-49).

It would have been obvious to one having ordinary skill in the art at the time the invention was made to modify Quatse to include determining whether said calling party may be interested in subscribing to any available additional phone number, because the subscription would generate additional revenue to telephone companies, as specifically stated in Trell (column 5, lines 44-50).

Dependent Claims.

Claim 2. See claim 1.

Claim 3. Quatse teaches: automatically communicating to the subscriber (column 4, line 63 – column 5, line 14).

Claims 4-6. See claim 1.

Claims 7-9. Trell teaches: generating said at least one second phone number (column 5, lines 44-50).

Claims 11-13. See claim 1.

Claim 14. Trell teaches said method and system, wherein said calling party is one of a service provider, telephone operator, and directory assistance provider (column 2, lines 50-58).

Claim 15. See claim 1.

Claim 16. Quatse teaches: receiving dialed digits entered by said calling party, said digits identifying a selected one of said options offered (column 5, lines 1-14).

Claim 17. Trell teaches: receiving speech from said calling party by operator (column 5, lines 58-59).

Claims 18-19. Trell teaches said method and system, wherein the subscriber initiates additional phone number request before said additional phone number is determined (column 2, lines 50-63).

Claim 20. Quatse teaches: receiving a communication from the subscriber wherein said received communication is any communication other than that of a subscriber initiated request for subscribing to an available phone number (column 2, lines 8-9).

Claim 25. See claim 1.

Claim 10 is rejected under 35 U.S.C. 103(a) as being unpatentable over Quatse and Trell.

Claim 10. Quatse and Trell teach all the limitations of **claim 10**, except that the first phone number and said second phone number are one of a contiguous, same area code, same central exchange, and same block of 10, 100, 1,000 or 10,000 numbers.

However, these differences are only found in the nonfunctional descriptive material and are not functionally involved in the steps recited. The "Determining" through "Communicating" steps would be performed the same regardless of the specifics of numbers generated. Thus, this descriptive material will not distinguish the claimed invention from the prior art in terms of patentability, see *In re Gulack*, 703 F.2d 1381, 1385, 217 USPQ 401, 404 (Fed. Cir. 1983); *In re Lowry*, 32 F.3d 1579, 32 USPQ2d 1031 (Fed. Cir. 1994).

Conclusion

The prior art made of record and not relied upon is considered pertinent to applicant's disclosure (see form PTO-892).

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Any inquiry concerning this communication should be directed to Igor Borissov at telephone number (703) 305-4649.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the Receptionist whose telephone number is (703) 872-9306.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's Supervisor, John Weiss, can be reached at (703) 308-2702.

Any response to this action should be mailed to:

Commissioner of Patents and Trademarks

Washington D.C. 20231

or faxed to:

(703) 872-9306 [Official communications; including After Final communications labeled "Box AF"]

Hand delivered responses should be brought to Crystal Park 5, 2451 Crystal Drive, Arlington, VA, 7th floor receptionist.

DR

John G. Weiss
JOHN G. WEISS
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